

REMARKS

Claims 1, 5-6, 8-16, 18-24 and 26 are pending in this application. Claims 2-4, 7, 17 and 25 were cancelled previously. Claims 1, 13, 20 and 24 are the independent claims.

The indication of allowability of claims 13-16, 18-24 and 26 is gratefully acknowledged.

Independent claim 1 has been amended to recite a method for transmultiplexing a data stream carried on a synchronous network so that the data stream can be carried on a plesiochronous network. Claim 1 has also been amended to recite that the data is extracted from a data stream carried on a synchronous network. Finally, claim 1 has also been amended to recite the step of transmitting the data stream according to the plesiochronous network onto a plesiochronous network.

Rejection Under 35 U.S.C §101

Claims 1, 5-6 and 8-12 were rejected under 35 U.S.C. 101 as allegedly not falling within one of the four statutory categories of invention. In particular, the Examiner asserts that the claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps and therefore do not qualify as a statutory process. The Examiner also asserts that the claimed steps could be performed mentally or manually. For the reasons detailed below, Applicants respectfully submit that claim 1 as amended constitutes patentable subject matter under 35 U.S.C. 101.

As the Federal Circuit has recently articulated, a claimed process is directed to statutory subject matter, if “(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008). In a recent Patent Board of Appeals and Interferences (PBAI) decision applying *In re Bilski*, the PBAI found that the recitation of a “programmed computer” within the preamble of a claim did not sufficiently tie process claims to a machine, and therefore was not patentable subject matter. *Ex parte Halligan*,

App. 2008-1588 (PBAI November 24, 2008) *Halligan* concluded that such a “recitation fails to impose any meaningful limits on the claim’s scope as it adds nothing more than a general purpose computer that has been programmed in an unspecified manner to implement the functional steps recited in the claims.”

Claim 1 has been amended to recite a method for transmultiplexing a data stream carried on a synchronous network so that the data stream can be carried on a plesiochronous network. Therefore, in contrast to the general purpose computer recited in *Halligan*, for instance, claim 1 is directed to a very particular type of machine, namely, a communication system, and even more specifically to two very particular types of communication systems, synchronous networks and plesiochronous networks. Claim 1 is thus believed to be directed to statutory subject matter because the claim is directed to a particular machine or apparatus since it is specifically directed to very specialized types of communication systems and addresses a very particular issue that arises in such systems, namely, the integration of synchronous and plesiochronous networks to allow plesiochronous traffic to be carried by synchronous equipment.

In summary, synchronous and plesiochronous networks are in fact very particularized types of systems or machines; they are not simply a generic machine that fails to provide meaningful limitations on the claim’s scope. The recitation in amended claim 1 of an optical communication system thus clearly ties the claim to a particular type of machine, namely, synchronous and plesiochronous networks and addresses a particular issue – integration of such networks– that arises in such networks.

In regard to the Examiner’s assertion that the claimed steps could be performed mentally or manually, claim 1 as amended includes the steps of extracting data from a data stream carried on a synchronous network and transmitting the data stream according to the plesiochronous network onto a plesiochronous network. Applicants respectfully submit that these steps cannot be performed mentally or manually.

Thus, for all these reasons the rejection of claim 1 and the claims that depend therefrom under 35 U.S.C §101 should be reconsidered and withdrawn.

CONCLUSION

Applicant submits that all of the pending claims are now in condition for allowance, an indication of which is respectfully solicited. If the Examiner believes there are still unresolved issues, a telephone call to the undersigned would be welcomed.

FEES

While it is not believed that any fees are due as a result of this Amendment, any fees that may be due and owing may be charged to the undersigned attorney's PTO Deposit Account No. 50-1047.

Respectfully submitted,

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